

REMARKS

Claims 1-25, 27, and 29-40 are currently pending, with claims 1, 25, 30, and 31 being independent. Claim 28 has been cancelled without prejudice or disclaimer of subject matter. New claims 31-40 have been added. Reconsideration and further examination are requested.

Allowable Subject Matter

Initially, Applicant thanks Examiner Walsh for his helpful indication of particular subject matter recited in the specification that, if incorporated into the claims, would overcome the cited references. Specifically, at page 5, ¶ 9, the Office Action notes:

“[I]t appears the applicant’s disclosure at p. 11, lines 19-21 disclosing the object saved to a repository separate from the electronic message and in combination with p. 13, lines 23-29 disclosing the benefit of automatically saving the image that was sent with the email to a repository such that the user can reuse the image without having to open the email currently distinguish the applicant’s invention from the current prior art of record.”

New claim 31 has been added and it is believed allowable in light of the inadequacies of the prior art.

Claim Objections

Claim 28 has been objected to for failing to further limit the subject matter of a previous claim. The Office Action rightly points out that claim 28 “recites the term ‘distinguishing’ rather than the term ‘identifying’”, seemingly appreciating the distinction among the language recited by these claims. To this point, claim 1 recites: “identifying an embedded multimedia object embedded within the identified electronic message or an attached multimedia object attached to the identified electronic message.” In contrast, claim 28 recites: “distinguishing the embedded multimedia object or the attached multimedia object from the electronic message.” However, the Office Action goes on to suggest that “the terms have been interpreted and defined to cover the same scope as ‘recognizing.’” Without acquiescing, but instead to advance prosecution, Applicant has cancelled claim 28.

Section 101 Rejections

Claims 1-24 and 28-30 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1 and 30 have been amended to address the Examiner's concerns. Therefore, withdrawal of the section 101 rejection is respectfully requested.

Section 112 Rejections

Claims 1-25 and 28-30 were rejected under 35 U.S.C. §112, first paragraph. In particular, the Office Action asserts that the claims contain subject matter which was not described in the specification. With regard to claims 1, 5, 24, 25, and 30 the Office Action asserts that the specification does not disclose “delivering the electronic message to the destination with an un-altered viewable version of the identified multimedia object’ after being saved.” The Office Action further suggests that the Specification “does not disclose that [after the object is extracted and separated [sic]] the message is then sent onward to a further destination.” For the following reasons, these positions are believed moot and otherwise flawed.

First, these positions are believed to be moot. Specifically, the Office Action has read the claim to require a particular sequence in which the multimedia object is saved; delivering the electronic message to the destination after being saved. However, the claims do not contain any such limitation. Rather, claim 1 recites: “delivering the electronic message to the destination with an un-altered, viewable version of the identified multimedia object and automatically saving the un-altered, viewable version of the identified multimedia object to a repository for subsequent use by a user.” As such, a suggestion that the specification lacks description of such a sequence is moot.

Second, these positions are otherwise believed to be flawed since the specification supports delivering the electronic message with the attached and/or embedded multimedia object to the requestor system, and storing the multimedia object in both a central repository and the requestor system. In particular, the Specification states “the multimedia objects may be stored in both a central repository (e.g., multimedia object repository 380) and in a local repository (e.g., electronic data store 385).” Specification, p. 10, lines 6-8. Furthermore, a local repository is defined as a “repository that is local to the user” (Specification, p. 9, lines 30-31), and an electronic data store as “connected to or contained within the requestor system” (Specification, p.

8, lines 29-30). Moreover, the Specification states that “the electronic message with the attached and/or embedded multimedia object may be forwarded by the multimedia object process server 370 to the requestor system 305.” Specification, p. 10, lines 2-4. As such, the Specification clearly supports the claim language.

Therefore, withdrawal of the section 112 rejections is respectfully requested.

Conclusion

All of the pending issues have been addressed. However, the absence of a reply to a specific rejection, objection, issue, or comment, including the Office Action's characterizations of the references, does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment or cancellation. Since the amendments made herein have been made solely in an effort to expedite advancement of this case, the Applicant reserves the right to prosecute the rejected claims in further prosecution of this or related applications.

No other matters being raised, the Applicant submits that the entire application is fully in condition for allowance, and such action is courteously solicited.

In the event that there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone Applicant's undersigned representative at the number set out below so that prosecution of the application may be expedited.

Applicant : David Gang et al.
Serial No. : 10/715,210
Filed : November 18, 2003
Page : 13 of 13

Attorney's Docket No.: 06975-0504001

The Excess Claims fee of \$688.00 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply charges not otherwise paid, or apply any credits to, deposit account 06-1050.

Respectfully submitted,

Date: August 13, 2009

/W. Karl Renner/

W. Karl Renner
Reg. No. 41265

Customer No. 26171
Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

40586255